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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,409

Applicant(s)

GALEA, NICHOLAS PAUL
ANDREW

Examiner

Beemnet W. Dada

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in reply to an amendment filed on June 17, 2005. Claims 1, -4, 11, 15, 18-20 and 24 have been amended. Claims 1-30 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention or teach an anti-virus system or method for removing tags and operable program code from an electronic mail message **without scanning the electronic mail message** for strings of characters which are known to be included in known viruses.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1- 6, 11-15, 17-20 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji et al US Patent 5,889,943 (hereinafter Ji) in view of Ko US Patent 6,697,950.

6. As per claims 1 and 15, Ji teaches an anti-virus system for an electronic mail message [see abstract], the system including detecting means for determining the presence of the electronic mail message [column 11, lines 51-53, and column 8, lines 42-67]; analysis and scanning detecting means for analysing and scanning the electronic mail message for tags (for example for file extensions, and/or portions of messages that begin with a line such as 'begin filename' and end with a line such as 'end' ") indicating the presence of operable program code [col. 11, line 53–col. 12, line 3, and col. 8, line 50–col. 9, line 3, col. 12, lines 18-31] and for removing any such tags and operable program code from the electronic mail message [col. 12, lines 47-49, 56-58]; and application means for applying the electronic mail message, with the tags and operable program code removed, to server means [col. 12, lines 47-49, 56-58]. Ji is silent on scanning for script tags and operable program codes without scanning the electronic message for strings of character which are known to be included in known viruses. However Ko et al teaches an anti-virus system/method including scanning for script tags and operable program codes without scanning the electronic message for strings of character which are known to be included in known viruses (i.e., scanning for macro operations) [column 5, lines 50 – column 6, line 17 and column 6, lines 34-47]. Both Ji and Ko teach an anti-virus system for removing operable program code. It would have been obvious to one having ordinary skill in the art at the time of applicants invention to employ the teachings of Ko within the system of Ji in order to further allow elimination of Macro viruses from a system and further enhance security of the system.

7. As per claims 2 and 17, Ji further teaches the system wherein a message body part is scanned for viruses [column 11, lines 54-67 and column 12, lines 1-14] and an attachment part of the message is scanned for viruses [column 19, lines 40-67 and column 20 lines 1-27].

8. As per claims 3 and 18, Ji further teaches the scanning means comprise scanning means for scanning the message for predetermined character strings [column 11, lines 59-63].

9. As per claims 4-5 and 19-20, Ji further teaches replacement means for replacing the removed tag and operable program code with alternative text [column 12, lines 54-57].

10. As per claims 6, Ji further teaches scanning means for scanning attachments for operable macros [col. 11, line 53–col. 12, line 3, and col. 8, line 50–col. 9, line 3, col. 12, lines 18-31].

11. As per claims 11 and 12, Ji further teaches the scanning means comprise scanning means for scanning the message for predetermined character strings [column 11, lines 59-63].

12. As per claims 13-14 and 26-27, Ji further teaches capturing electronic messages passing between a first network and a second network [column 11, lines 50-57].

13. As per claims 28-30, Ji further teaches a computer program comprising code means for performing all the steps of the method of claim 15 when the program is run on one or more computers [column 3, lines 13-18].

14. Claims 7-10 and 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji US Patent 5,889,943 in view of Ko US Patent 6,697,950 as applied above and further in view of Kim et al. US Patent 6,701,440 (hereinafter Kim).

15. As per claims 7, 16 and 21, the combination of Ji and Ko teaches the system as applied above. Ji further teaches storing encode portions of a message containing viruses in a specified directory [column 12, lines 49-54]. Ji-Ko does not explicitly teach quarantining an attachment containing a macro or operable program code. However, Kim teaches a remote e-mail scanning device [see abstract], including quarantine means for quarantining a constituent body containing operable program code and/or removing from the message and quarantining an attachment containing a macro or operable program code [column 8, lines 57-67 and column 9, lines 1-19]. Both Ji-Ko and Kim teach an anti-virus system for electronic messages. It would have been obvious to one having ordinary skill in the art at the time of the applicant invention to modify the teachings of Kim within the system of Ji-Ko in order to enhance the security of the system by quarantining messages containing operable program code.

16. As per claim 8, Kim further teaches the system wherein the quarantine means includes means for removing a macro from an attachment, quarantining the macro and releasing the attachment with the macro removed [column lines 8, 57-67 and column 9, lines 1-19].

17. As per claims 9 and 22, Kim further teaches the system wherein the quarantine means includes means for storing the constituent body, attachment or macro in a quarantine storage location as a quarantined item, receiving means for receiving a input indicating a decision

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whether the quarantined item may be delivered to an intended recipient, and dependant on the decision input either releasing the quarantined item for delivery to the intended recipient with or without the operable code removed or deleting the quarantined item [column 8, lines 57-67 and column 9, lines 1-29].

18. As per claims 10 and 23, Kim further teaches the system wherein the quarantine means includes informing means, on deleting the quarantined item, for informing the intended recipient and/or a sender of the message that the quarantined item has been deleted without being delivered to the intended recipient [column 9, lines 1-29].

19. As per claim 24, Kim further teaches the system wherein the scanning means for scanning attachments for operable macros comprises means for sequentially scanning the attachments for a plurality of predetermined character strings [column 1, lines 30-37 and column 5, lines 30-34].

20. As per claim 25, Kim further teaches the system wherein the means for scanning attachments for a plurality of predetermined character strings includes termination means for terminating scanning when one of the predetermined strings is not found on completely scanning the attachment [column 1, lines 30-37 and column 5, lines 30-35].

Response to Arguments

21. Applicant's arguments filed June 17, 2005 have been fully considered but they are not persuasive.

22. Regarding the issue of the amendment to independent claims 1 and 15, where the claims were amended to include the phrase "without scanning the electronic message for strings of characters which are known to be included in known viruses", the examiner cites MPEP 2173.05(i)

"Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."

The amended phrase clearly recites a negative limitation. Indeed, the specification must contain a full, clear and concise description of the claimed subject matter. The specification does not literally or implicitly exclude scanning for tags and operable program codes without scanning the electronic message for strings of characters which are known to be included in known viruses.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

September 5, 2005


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2135